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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,136	12/18/2001	Stephen W. Comiskey	53326.000012	9781

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HUNTON & WILLIAMS  
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WASHINGTON, DC 20006

EXAMINER

PURVIS, SUE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<b>Application No.</b> 10/020,136	<b>Applicant(s)</b> COMISKEY ET AL.	
	<b>Examiner</b> Sue A. Purvis	<b>Art Unit</b> 1734	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 22 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: \_\_\_\_\_.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
 13. ☒ Other: PTO-892.

Sue A. Purvis  
Primary Examiner  
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***Response to Arguments***

1. Applicant's arguments filed 22 August 2005 have been fully considered but are not persuasive.

2. Regarding the rejection under 35 U.S.C. 103(a) for claims 21-24 and 31-34, applicant argues on pages 8 and 9 of their response that the embodiment of Figure 7 is evidenced by the language set forth in claim 21. In particular, "a shape formed within the exterior surface, wherein the shape has a color contrasting to the non-reflective color and is configured to provide communication." It has been admitted that Micchia does not disclose this feature, but the examiner disagrees with applicant's assertion that Essig does not disclose this feature. Essig teaches that the design includes a particular hue or color and that the surface also includes partial ornamental material (14). It is the examiner's position that the ornamental material contrasts sufficiently to meet the claim limitation and provides a form of communication. It is appreciated the communication may not be exactly what the applicant is trying to do in the instant case as set forth in the specification, but it is the examiner's responsibility to give the claims their broadest reasonable interpretation without reading limitations from the specification into the claims. Communication as defined in the Merriam-Webster Online Dictionary as "a process by which information is exchanged between individuals through a common system of symbols, signs, or behavior." The applicant's specification discusses communication as "providing a non-verbal communication to others in a simple and effective manner, particularly one that lends itself to commercial advertisement or sports team promotion." The decoration in Essig is sufficient to communicate by a symbol, in particular the butterfly but also the interior marks (14) communicate as they are too a symbol.

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3. In response to applicant's arguments on page 10 of the response that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applicant is simplifying the motivation used by the examiner in their response on pages 10 and 11. The motivation is not simply that Essig discloses an ornamental decal. Micchia teaches placing a decal under the eye; Essig teaches there is a desire that a decal placed on the body be ornamental to make it nicer for an observer to look at. This is also shown in Frankel (US Patent No. 1,140,975) and DeMatteo et al (US Patent No. 4,783,350), neither of which were used in the original rejection and are not meant to modify that rejection. But both Frankel and DeMatteo demonstrate that the motivation used by the examiner is not only from Essig, but also one of ordinary skill in the art. It is appreciated that decals applied to the face or body are more appealing if they contain some decoration thereon, rather than just the black design used in Micchia.

4. In response to applicant's argument on page 10 of the response that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As demonstrated above, the knowledge used to combine Micchia and Essig does not only come

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from applicant's disclosure, it comes from the teachings in Essig and from knowledge generally known to one of ordinary skill as demonstrated by Frankel and DeMatteo.

5. In response to applicant's arguments on page 10 against the reference Essig individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that since the beauty mark in Essig has perfume it is not combinable with Micchia. In particular, applicant suggests that the perfume would be in the decal used under the eye. This is simply not the case. The examiner has in no way suggested that perfume would be used in an under-eye decal in the combination of Essig with Micchia. Essig was relied on to show there is motivation for a decal to be decorative, not that a decal should have perfume. Frankel and DeMatteo, which are being used only to show that decorative decals are well known, do not have perfume. It is the use of decoration on the decal that was of interest to the examiner, not the use of perfume.

6. In response to applicant's arguments on page 11 that the Office Action has failed to set forth a *prima facie* case of obviousness, the examiner disagrees. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Essig teaches that it is desirable to have a decorative decal and that teaching is sufficient to suggest the combination. Furthermore, a decorative decal provides communication as it is defined in the specification and in Merriam-Webster Dictionary.

7. Regarding the arguments set forth on page 12 of the response by the applicant, they are sufficiently addressed above and the examiner will not repeat them.

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8. Regarding the rejection under 35 U.S.C. 103(a) for claims 26-30 and 36-40, the arguments set forth by the applicant are dealt with above.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
September 9, 2005